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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,139	04/26/2001	Hideharu Takeshima	206488US0	6553

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OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC  
FOURTH FLOOR  
1755 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202

EXAMINER

LE, MINH

ART UNIT

PAPER NUMBER

2652

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/842,139

Applicant(s)

TAKESHIMA ET AL.

Examiner

Minh Le

Art Unit

2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-4, 6, 7, 10, 13, 14, and 16 rejected under 35 U.S.C. 102(e) as being anticipated by Komaki (U.S. Patent No. 6,437,017).

As to claims 1, 2 and 10, Komaki shows in Fig. 1 an optical recording medium including a print-receiving layer 7 as the entire area of the outermost layer on the side opposite to the light incidence side, wherein a pattern is formed on the print-receiving layer by color (Col. 5, lines 33-41; Col. 12, lines 66-67; and Col. 13, lines 1-3).

As to claims 3, 4, 6, 7, 13, 14 and 16, Komaki teaches the optical recording medium including the print receiving layer which, is printable with water base ink by means of an ink jet printer, and contains fine particles having an average particle size of at most 200 nm and a cation resin (Col. 9, lines 31-33; Col. 14, lines 27; and Col. 13, lines 1-3).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 8, and 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Komaki (U.S. Patent No. 6,437,017) in view of Koike et al (U.S. Patent No. 5,492,744).

As to claims 5, 8 and 9, Komaki shows in Fig. 1 the optical recording medium including a print-receiving layer 7 as the outermost layer on the side opposite to the light incidence side (Col. 5, lines 33-41; Col. 12, lines 66-67; and Col. 13, lines 1-3). But Komaki does not teach the optical recording medium; wherein a pattern is formed on a layer by concaves or convexes, and the difference in height of the concave/convex is at least 0.5  $\mu\text{m}$ .

However, Koike discloses the optical recording medium, wherein a pattern is formed by concaves or convexes, and the "concave and convex portion of about 3  $\mu\text{m}$  depth or less may be form on purpose" (Col. 13, lines 19-22).

It would have been obvious to a person having ordinary skill in the art at the time the inventions was made to provide the optical recording medium of Komaki with the concave/convex pattern being formed on the print-receiving layer as taught by Koike. The rationale is as follow: one of the ordinary skill in the art at the time the invention was made would have been motivated to provide an optical recording medium with the concave/convex pattern on the print-receiving layer to make "the CD-R media having a low error rate and good recording properties", as taught by Koike (Col. 23, lines 16-18).

Art Unit: 2652

5. Claims 11, 12 and 15 rejected under 35 U.S.C. 103(a) as being unpatentable over Komaki (U.S. Patent No. 6,437,017) in view of Koike et al. (U.S. Patent No. 5,492,744) as applied to claims 5, 8, and 9 above, and further in view of Gillery (U.S. Patent No. 4,920,006).

As to claims 11, 12 and 15, Komaki and Koike do not teach the optical recording medium, wherein the XYZ color system chromaticity coordinate (x, y) of the reflected light at an optional portion on the print-receiving layer satisfies the formula (1), and the XYZ color system chromaticity coordinates (x1, y1) and (x2, y2) of the reflected light at two optional portions satisfy the formula (2):

$$(x - 0.32)^2 + (y - 0.32)^2 \leq 0.015 \quad (1)$$

$$(x_1 - x_2)^2 + (y_1 - y_2)^2 \leq 0.012 \quad (2)$$

However, Gillery shows in table II (Col. 5) the XYZ color system chromaticity coordinate (x, y) of the reflected light at an optional portion on the print-receiving layer satisfies the formula (1), and the XYZ color system chromaticity coordinates (x1, y1) and (x2, y2) of the reflected light at two optional portions satisfy the formula (2).

It would have been obvious to a person having ordinary skill in the art at the time the inventions was made to provide the optical recording medium of Komaki and Koike with the XYZ color system chromaticity coordinate (x, y) of the reflected light at a portion on the print-receiving layer satisfies the formula (1), and the XYZ color system chromaticity coordinates (x1, y1) and (x2, y2) of the reflected light at two portions satisfy the formula (2) as taught by Gillery. The rationale is as follow: one of the ordinary skill in the art at the time the invention was made would have been motivated to provide the optical recording medium with the XYZ color system chromaticity coordinate (x, y) of the reflected light at a portion on the print-receiving layer

Art Unit: 2652

satisfies the formula (1), and the XYZ color system chromaticity coordinates (x1, y1) and (x2, y2) of the reflected light at two portions satisfy the formula (2) to make a novel superior dielectric film for use in a wide variety of colored multiple-layer coatings with relatively saturated colors, as taught by Gillery (Col. 2, lines 25-36).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Le whose telephone number is (703) 305-7867. The examiner can normally be reached on 10:00AM - 7:00PM (Mon- Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T Nguyen can be reached on (703) 305-9687. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3718 for regular communications and (703) 305-3718 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
DAVID DAVIS  
PRIMARY EXAMINER

ML  
October 16, 2002